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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOEL FREDERIC PLOTKIN

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Appeal 2007-4549  
Application 09/513,960  
Technology Center 3600

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Decided: March 11, 2009<sup>1</sup>

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Before, HUBERT C. LORIN, ANTON W. FETTING, and  
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1, 2, 4-12, 14-34. We have jurisdiction under 35 U.S.C. § 6(b) (2002).<sup>2</sup>

## SUMMARY OF DECISION

We AFFIRM IN PART.

### THE INVENTION

Appellant claims a system and method for document review  
(Specification 1:5-7)

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A computer implemented manuscript review  
and determination process, comprising:

receiving manuscript data defining a  
manuscript including at least one of text data,

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<sup>2</sup> After the Reply Brief of 8/25/06 was filed the case was forwarded to the Board and jurisdiction passed to the Board on 7/30/2007. While the case was under the jurisdiction of the Board, the Examiner filed a Supplemental Examiner's Answer on 12/4/08. A Supplemental Reply Brief was filed on 2/6/09 in response to the Supplemental Examiner's Answer. Both the Supplemental Examiner's Answer's and the Supplemental Reply Brief have not been considered by the Board because the case was under jurisdiction of the Board and the Examiner could not formally enter papers into the application at that point in time. The application had not been remanded to the Examiner by the Board or properly ordered sua sponte to the Examiner by Director. Accordingly, the Supplemental Examiner's Answer's and the Supplemental Reply Brief have not been considered in this Decision since they are not formally entered and therefore cannot be considered (see MPEP Section 1210).

audio data, and video data;

prompting a potential reviewer for  
agreement to review said manuscript;

storing agreement data received from said  
potential reviewer, said agreement data including  
at least one of agreement to review and  
disagreement to review said manuscript; and

storing a decision whether to publish.

### THE REJECTIONS

The Examiner relies upon the following as evidence of  
unpatentability:

Hager	5,377,355	Dec. 27, 1994
Plantz	6,088,702	Jul. 11, 2000
Price	“Peering Into Peer Review”	Nov./Dec. 1995

The following rejections are before us for review.<sup>3</sup>

The Examiner rejected claims 1-2, 4-12, 14-27, and 29-34 under  
35 USC 103(a) as being unpatentable over Plantz in view of Hager.

The Examiner rejected claim 28 under 35 USC § 103 (a) as being  
unpatentable over Plantz in view of Hager and further in view of Price.

### ISSUE

Has Appellant shown that the Examiner erred in rejecting claims 1-2,  
4-12, 14-27, and 29-34 on appeal as being unpatentable under 35 U.S.C.  
§ 103(a) on the grounds that a person with ordinary skill in the art would

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<sup>3</sup> The 35 U.S.C. § 101 and 35 U.S.C. 112, First Paragraph Rejections were  
withdrawn by the Examiner in the Answer.

understand that Plantz discloses a reviewer in the form of an editor and that providing such an editor an application to obtain a user name and password to be a reviewer of a document is an act of prompting such a person to agree to work on the document?

### FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. The Specification discloses that “[r]eviewers report either directly or indirectly to the monitoring/associate editor or editor of the publication.

Specification, p. 5.

2. Specification does not specifically define the term “agreement data”, nor does it utilize the term contrary to its customary meaning.

3. Plantz discloses that the editor access to a work is only permitted by prior authorization in that:

...[T]he top-level 101 of the GPS, users select from among a menu of document project(s) (102, 103, 104) to which that author or editor has previously received access authorization. The prior authorization to access a given project or document is arranged by any of a number of means acceptable [to] both the contributing author or editor, and the overall manager of the GPS for the document being assembled. For example, in-person, telephonic, facsimile, standard mail, e-mail or like communication between the GPS project manager and the author or editor allows for convenient authorization of usernames and passwords.

Col. 8, ll.20-30

4. In order for an editor to begin an editing session, a user of the GPS of this invention

begins an editing session by accessing the gateway

or top-level of the GPS URL, through which the user is permitted access to the document to be edited or authored. To prevent unauthorized access, the GPS requires each user to provide a username and a password to access the editing module of the system. Once an editing session is in progress, the system allows no other user to access the editing module for that document, or edited document segment, until the first user's editing session has ended. The GPS provides a control window, or interface, which allows the user to edit the document according to a style specified by the overall administrator of the GPS assembled project, to edit only a part of the document, or to select additional modules which facilitate uploading of other data, . . . Text data is entered directly into the system.

Plantz, Col. 7, ll. 28-43.

5. The Examiner found that the limitations of claims 4 and 14 are disclosed in Plantz at col. 10, ll. 4-14 and col. 9 ll. 56-62. Answer 4.

6. Plantz discloses various editors in that:

...an editor logs-in upon performing the same initial steps up to the point where a selection of "author" 131 or "editor" 132 has to be made. Selection of the "editor" option 132, initiates a GPS subroutine 180 calling for the authorized editor to supply their username 181 and password 182. In addition, a selection 183 of the type of editor (e.g. medical, pharmaceutical, grammatical, etc.), is entered. At this level, it is also possible for a new editor to supply a username and password for acceptance of the new editor as an expert, or by other criteria, for editing of an unassigned editing topic or aspect.

Col. 10, ll. 1-12

7. Plantz discloses:

173, 174, 175, 176 are displays of the completion date of assigned aspects of the editing tasks associated with the document completion (for example, for a medically related document, these sections might include editorial signoffs by medical, pharmaceutical, grammatical and other experts, as well as signoff, for example, by an executive editor.; editorial titles, naturally, vary with the project);

Col. 9, ll. 56-62.

8. Any editor in Plantz must acquire authorization and a password and

If a new editor signs into the system, his or her name is added to a GPS database of editor usernames and passwords, (see FIG. 9 for one embodiment of the layout for these functions). Upon providing the required log-in data, a log-in selection 184 executes the log-in command, and if approved username and password data are supplied by the user, access is provided to a menu 190 of topics, subtopics, or chapters 191, 192, 193 for which work by the authors is complete and which await editing. A menu 194 of topics that have already been edited by this editor and which are approved for further editing by other types of editors (e.g. by the grammar editors) is also preferably provided. A further menu 195 may be selected for topics that have been assigned to the editor but are not ready to be edited. The editor selects and highlights the desired topic and downloads that segment of the document by selecting 196, "View/Edit Chapter," (see FIG. 10 for one embodiment of the layout for these functions).

Col. 10, ll. 13-29.

9. In Plantz,  
a selection 210 permitting the editor to enter personal information such as their name, address, telephone number and similar data; 211 is a display of the date and time when the document was last modified; 212 displays the date on which the document was finally completed; 213, 214, 215, 216 are displays of the completion date of assigned aspects of the editing tasks associated with the document completion (for example, for a medically related document, these sections might include editorial signoffs by medical, pharmaceutical, grammatical and other experts, as well as signoff, for example, by an executive editor.; editorial titles, naturally, vary with the project); 217 provides a link to one or more particularly desirable databases or search engines (for example, for a medically related document, having a live link to a Medline Search engine at this point is preferred; see FIG. 11 for one embodiment of the layout for these functions).

Col. 10, ll. 45-62.

10. Plantz discloses that its Group Publishing System  
includes a means for tracking all document information, including but not limited to all information necessary to reproduce the document. In addition to document content, this information includes, but is not limited to, style and layout rules, spelling dictionaries and information obtained by following links and cross-references to other publications.  
The GPS ...also safeguards data, despite computer or network failures or attempts by

unauthorized users to modify the document. The current invention provides access control to prevent unauthorized persons from accessing and making changes to documents and projects.

(Col. 6, ll. 53-64)

11. Hager discloses that the purpose of voting on a disclosure document is to determine if the process is worth continuing with in that if:

a determination of whether or not the evaluations of the group of evaluators for a particular invention disclosure document have recommended that a search be conducted to determine the likelihood of patent protection for a particular invention disclosure, . . . the process passes to block 166. Block 166 illustrates the automated transmittal of a status letter to appropriate parties within the organization.

Hager Col. 10, ll. 28-36.

12. Hager discloses that if a person does not send a voting message to the committee the person will be prompted to does so in that:

... a determination of whether or not evaluator votes have been received with regard to a particular invention disclosure document. If not, the process merely iterates until such time as one or more evaluator votes have been received. Of course, those skilled in the art will appreciate that a prompting message may be utilized to induce an evaluator to submit a vote for a particular invention disclosure document in the event the evaluator has not done so within a preselected period of time.

Hager, Col. 9 ll. 28-37.

13. The Examiner found that:

Hager teaches determining whether evaluators votes have been received with regard to a particular document; and generating a prompting message to be utilized to induce an evaluator to submit a vote for the document if the evaluator has not done so within a preselected period of time . . . [and thus the] motivation to combine Plantz and Hager would be to combine in one system both reviewing and editorial functionality, thereby enhance the performance of the system and make it more attractive to customers.

Answer 5.

#### PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

## ANALYSIS

The rejections are affirmed as to claims 1, 2-14, 14-32, and reversed as to claims 33 and 34. The Appellant does not provide a substantive argument as to the separate patentability of claims 2, 12, 21, 22, 24 and 31<sup>4</sup> that depend from claims 1, 11 and 20, which are the sole independent claims among those claims. Claims 2, 12, and 21, 22, 24 and 31 fall with claims 1, 11 and 20. *See*, 37 C.F.R. § 41.37(c)(1)(vii) (2004).

### *Claims 1, 11 and 20*

Initially, we note that the Appellant argues these claims together as a group. Correspondingly, we select representative claim 1 to decide the appeal of these claims, remaining claims 11 and 20 standing or falling with claim 1.

First, Appellant argues that Plantz does not teach "prompting a potential reviewer for agreement to review said manuscript," as recited in claim 1.

The Examiner asserts that Plantz discloses "- receiving manuscript data defining a manuscript comprising at least one of text data, audio data, and video data [at] (column 7, lines 37-43, 58-63; column 8, lines 20-27; column 9, lines 24-31)". Answer 3. The Examiner's citation to Plantz at least in part requires that prior authorization to access a given document is

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<sup>4</sup> A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See*, 37 C.F.R. § 41.37 (c)(1)(vii) (2004)

arranged by any of a number of means acceptable to both the contributing author or editor, and the overall manager of the GPS (FF 3,4).

Appellant however attempts to distinguish claim 1 over these portions of Plantz by arguing a distinction between a “potential reviewer” and an editor is consequential to the determination of patentability stating a:

[p]otential reviewer refers to a reviewer assigned to a manuscript who has not yet accepted or rejected a request to review the manuscript. See page 5 lines 24-25. Manuscript review embodies the steps involved in approving or denying the manuscript for publication based at least in part upon reviews provided by reviewers.

Appeal Br. 16.

We are not persuaded of error in the rejection by Appellant’s arguments for two reasons. First, the Specification states that reviewers report either directly or indirectly to the editor of the publication (FF 1). Thus, an editor by this example has greater control over the document than a reviewer, and thus would be the most likely party with whom the author actually enters into agreement. Second Appellant’s argument fails because it is not based on limitations appearing in the claims and is not commensurate with the broader scope of claim 1 which does not recite and limitation of the reviewer approving or denying the manuscript for publication. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982).

Appellant next argues that

Furthermore, even if the editors in Plantz are equivalent to potential reviewers, Plantz does not teach that its editors are *prompted for agreement to review* a manuscript. As stated above, Plantz teaches that editors are *assigned*. Assigning a

person to author or edit a document is not equivalent to prompting a potential reviewer to review a document. Thus, Plantz teaches that editors are assigned to edit documents and need authorization rights to access that document, which is not equivalent to prompting a potential reviewer for agreement to review a manuscript as defined by independent claims 1, 11, and 20.

Appeal Br. 16-17. Emphasis original.

We disagree with Appellant because Plantz refers to access by perspective editors which are conditioned on approval by the author (FF 4,6) and in the case of a new editor to supply a username and password for acceptance of the new editor for editing of an unassigned editing topic or aspect (FF 6). Thus, Plantz refers to a new editor not as an assignee of a task, but rather as one awaiting approval for acceptance as would a potential candidate await acceptance for which he/she has applied.

Appellant argues that Plantz does not teach storing data equivalent to the claimed storing of agreement data. Appeal Br. 17. Appellant more specifically argues that the agreement data in Plantz does not include a yes/no value. First, Appellant's arguments "fail from the outset because . . . they are not based on limitations appearing in the claims . . .," and are not commensurate with the broader scope of claim 1 which merely recites "agreement data" and not an agree/disagree option. *In re Self*, 671 F.2d 1344, 1348 (CCPA 1982). Appellant's Specification does not specifically define the term "agreement data", nor does it utilize the term contrary to its customary meaning. (FF 2) Thus, we interpret any information related to the authorization of an editor to use the system (FF 5) as agreement data.

*Claims 4 and 14:*

Claims 4 and 14 recite: *storing data indicating an identification of an associate editor for said manuscript in association with said manuscript data*. The Examiner found that Plantz discloses this limitation at column 10 lines 4-14 and column 9 lines 56-62 (FF 5). The pertinent aspects of these portions of Plantz disclose editorial sign offs from editorial experts in addition to that of an executive editor being entered into the GSP database (FF 6,7) and a listing of topics that have already been edited by one editor and which are approved for further editing by other types of editors (e.g. by the grammar editors) (FF 8). We interpret editors, such as those who work on the document in addition to and at the direction of, for example, an executive editor to be associate editors as required by claims 4 and 14. Appellant argues that Plantz does not teach identification of an associate editor. (Appeal Br. 20-21) However, Plantz discloses supplying a username 181 and password 182 to all editors approved for work on a given document and thus answers the requirement of claims 4 and 14.

Appellant further attempts to distinguish over Plantz by arguing that "...the specification clearly defines an associate editor as one having less computer access rights than an editor. While Plantz teaches that there can be multiple editors, Plantz does not teach associate editors, who have less computer access rights than editors." (Appeal Br. 21) We do not agree with Appellant because Plantz refers to an executive editor which we infer includes heightened privileges to document control. *See KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ"). Even still, Plantz

discloses one editor approving further editing by others e.g., grammar editors (FF 8) which describes a hierarchical control over the involved document by one editor over another.

*Claims 5 and 15*

Claim 5 recites: *storing at least one date on which said associate editor performs at least one of assigning a potential reviewer and entering manuscript approval status data*. Appellant argues that:

...the only date that Plantz teaches displaying is the date and time when the document was last modified. See column 10 lines 48-49.

However, the date of last modification is not equivalent to any of the dates on which "said associate editor performs at least one of assigning a potential reviewer" or "*entering manuscript approval status data*," as recited by claim 5 and defined by claim 15.

Appeal Br. 23. Emphasis original.

We do not agree with Appellant's reading of Plantz to only disclose marking a date with respect to document last modification because Plantz discloses plural date markings (FF 9). Specifically, Plantz discloses marking dates with respect to the date on which the document was finally completed; the completion date of assigned aspects of the editing tasks associated with the document completion (FF 9). We interpret the entry of the completion date by the assigned reviewer/editor in Plantz to constitute a date on which the involved reviewer approves his or her portion of the review task for publication as required by the claims.

*Claims 6 and 16*

Claims 6 and 16 require: *storing a date on which at least one of receiving said manuscript, prompting a potential reviewer, and receiving agreement data occurs.*

Appellant argues that 1.) “Plantz only teaches one date; the date and time when the document was last modified” and 2.) “... the date of last modification is not equivalent to any of the dates for ‘receiving said manuscript, . . . prompting a potential reviewer,’ or ‘receiving agreement data.’” Appeal Br. 25. First, as discussed above, Plantz discloses plural date markings (FF 9), and thus this argument fails for the reasons set forth above. Second, Plantz discloses that its GPS includes means for tracking all document information (FF 10). Thus, it is clear from the disclosure in Plantz that the GPS would, as part of tracking all document information, also include the dates on which a given event occurs. This leads to the last of Appellant’s assertions that the events a. receiving a manuscript, b. assigning a potential reviewer, or c. receiving agreement data do not occur in Plantz. However, we infer from Plantz that a system which tracks all document information and safeguards that data (FF 9, 10) would, in the course of tracking and safeguarding data: a.) log in the date that the work is received, b.) when one editor passes the work off to another for expert editing and c. the date a new editor receives an approved user identification. *See KSR Int’l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (In making the obviousness determination one “can take account of the inferences and creative steps that a person of ordinary skill in the art would employ”). In light of the breadth of the claim, the Appellant’s argument is not persuasive as to error in the rejection.

*Claims 7-8 and 17-18*

Claims 7, 8 and 17 and 18 recite in pertinent part: *transmitting a manuscript review instruction to reviewer and authorizing transmission of said manuscript to at least one of associate editors of said manuscript, potential reviewers of said manuscript, and reviewers of said manuscript.*

Appellant argues that:

Plantz does not teach a system wherein manuscripts are transmitted to a potential reviewer. In Plantz, the document is stored in one location and editors and authors log onto that location to work on the document. In addition, an *author* may cut and paste a document from his/her computer to the GPS.

Appeal Br. 26. Emphasis original.

We disagree with Appellant as to error in the Examiner's rejection. Whether the document is sent to the next reviewer or whether the next reviewer is given access to a central database on which the document resides to make edits as occurs in Plantz cannot distinguish the claims from Plantz because such practices are equally predictable variations of one over the other. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR*, at 1739.

*Claims 9-10 and 19*

Claims 9, 19 and 19 recite: *wherein said authorizing transmission comprises storing, in association with said unique identification, at least one of an identification of an associate editor, a potential reviewer, and a reviewer and wherein said authorizing transmission comprises storing, in*

*association with said unique identification, an identification of an associate editor and a reviewer.*

Appellant argues that "...Plantz teaches storing the name of an editor, Plantz does not teach an authorizing transmission which comprises storing at least one of an identification of an associate editor, a potential reviewer, and a reviewer, as defined by claims 9-10, and 19." Appeal Br. 28.

In light of the breadth of the claim, the Appellant's argument is not persuasive as to error in the rejection because as discussed *supra* Plantz discloses associate editors as new editors (FF 6) and experts (FF 7), all of which are required to have a unique identification assigned them (user name and password) (FF 3,6) to effect transmission, e.g., access to the document.

*Claim 23*

Claim 23 recites: "*tracking said manuscript and storing said tracking information in a database; and sending a message upon completing a status check that includes whether a set of anticipated events, including receipt of a number of reviewers reviews and editors actions, occurred in a predetermined period of time.*"

The Examiner found that Hager teaches determining whether evaluators' votes have been received with regard to a particular document in a predetermined time, and it would be obvious to modify Plantz to include this feature. (FF 13)

Appellant argues that "... prompting an evaluator to submit a vote is not equivalent to sending a message upon completing a status check that includes whether a set of anticipated events . . . occurred in a predetermined period of time." Appeal Br. 31.

We disagree with Appellant. A vote in the Hager system is done within a computerize system (FF 11) for the purpose of advancing the project (FF 11,12) and thus is a message in that it conveys information yes/no from one person to another as to such advancement.

*Claim 25*

Claim 25 recites: *transmitting a signal prompting an additional potential reviewer for agreement to review said manuscript if said potential reviewer disagrees to review said manuscript.*

In Plantz, the GPS project manager using email or like communication maintains contact with the author and editors involved in the advancement of the document to publication (FF 3).

Appellant argues that because

“... Plantz does not teach that reviewers are *prompted* for agreement to review said manuscript... [because the] editors are *assigned* to review documents.” Appeal Br. 33. However, inaction by the assigned reviewer in Plantz would be, in our view, disagreement to review and thus warranting a prompting signal such as disclosed by Hager (FF 12) as discussed above.

In light of the breadth of the claim, the Appellant’s argument is not persuasive as to error in the rejection.

*Claim 26*

Claims 26 recites *wherein receiving manuscript data comprises receiving at a central computer manuscript data defining a completed manuscript transmitted from a remote terminal associated with an author; and said prompting a potential reviewer for agreement to review said manuscript comprises transmitting prompt data to a remote terminal*

*associated with said potential reviewer after receiving manuscript data defining a completed manuscript.*

Appellant argues that “Plantz teaches a system that an author logs onto and is authorized to contribute to documents. . . . While Plantz teaches that data may be transferred from the author's computer to the GPS system, Plantz does not teach that this data is a *completed* manuscript.” Appeal Br. 35. Again whether a document resides on a server and edits are made on it until the document is completed versus one that is circulated before completion cannot distinguish the claims from Plantz because such practices are equally predictable variations of one over the other. “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, at 1739, 82 USPQ2d at 1396.

Regarding the prompting of a message indicating a completed status, we note that Plantz does track completed assignment (FF 7) and the follow-up with a prompt of acknowledgement would follow from the teaching in Hager of prompting a worker on a task related matter.

*Claim 27*

Claim 27 recites *wherein receiving manuscript data comprises receiving at a central computer manuscript data defining a completed manuscript transmitted from a remote terminal associated with an author; and in response to receiving said completed manuscript at said central computer automatically prompting a potential reviewer for agreement to review said completed manuscript.*

Appellant argues Plantz does not teach automatic prompting of a potential reviewer for an agreement. We disagree with Appellant.

Plantz refers to access by perspective editors are conditioned on approval by the author (FF 4, 8) and in the case of a new editor to supply a username and password for acceptance of the new editor for editing of an unassigned editing topic or aspect (FF 6). Thus, we interpret the required application by a new editor for a user name and password as automatically prompting a potential reviewer for agreement to review said completed manuscript. Accordingly, Appellant's argument is not persuasive as to error in the rejection.

*Claims 29-30*

Claims 29 and 30 recite: *storing data indicating an identification of a first associate editor for said manuscript in association with said manuscript data and an identification of an editor, wherein said editor has rights to assign at least one second associate editor for said manuscript and said first associate editor does not have rights to assign any associate editor for said manuscript and storing data indicating an identification of a first associate editor for said manuscript in association with said manuscript data; storing data indicating an identity of an editor; wherein said associate editor has less rights relating to said manuscript than said editor.*

Appellant argues that "Plantz teaches that there may be multiple editors; however, it does not teach identification of an associate editor (see similar argument for claims 4 and 14, *supra*).” Appeal Br. 40. Emphasis original. Appellant's argument to claims 4 and 14 were not persuasive as to error in that rejection and are not persuasive for the same reasons here.

*Claims 32-34*

Claims 32 and 33 recite: *storing at said central computer different rights relating to a manuscript for users defined as author, editor, associate editor, and reviewer and configuring said central computer wherein a user defined as an author of said manuscript has rights to get status information relating to said manuscript, a user defined as an editor has rights to assign associate editors to said manuscript, assign reviewers to said manuscript, view, authorize publication, and get status information for said manuscript, a user defined as an associate editor for said manuscript has rights to assign reviewers to said manuscript, view, authorize publication, and get status information for said manuscript and does not have rights to assign additional associate editors to said manuscript, a user defined as a reviewer of a manuscript has rights to indicate whether said manuscript should be published, and get status information on said manuscript.*

Appellant argues that the general limitation of claim 32 is not taught by Plantz because “...to the extent that Plantz teaches multiple editors, that disclosure fails to suggest ‘storing . . . different rights relating to a manuscript for users defined as author, editor, associate editor, and reviewer’”. Appeal Br. 45. We disagree with Appellant because as discussed supra with regard to claims 4 and 14 Plantz refers to an executive editor which we infer has heightened privileges to document control. *See KSR Int’l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007) (In making the obviousness determination one “can take account of the inferences and creative steps that a person of ordinary skill in the art would employ”). Even still, Plantz discloses one editor approving further editing by others e.g.,

grammar editors (FF 8) which describes a hierarchical control over the involved document by one editor over another.

However, with respect to the subject matter of claim 33, we agree with the Appellant that neither Plantz or Hager disclose the specific details of how each party is defined by specific rights nor has the Examiner provided reasoning or other findings why a person with ordinary skill in the art would have divided the access rights in the manner as claimed.

Accordingly we do not sustain the rejection of claim 33 and because claim 34 depends from claim 33, and since we cannot sustain the rejection of claim 33, the rejection of claim 34 likewise cannot be sustained.

*No motivation to combine*

Appellant argues that Plantz and Hager “...provide no motivation to modify one in view of the other...”, Appeal Br. 18, and “...that there is no motivation to combine Price with the teachings of Plantz in view, of Hager.” Appeal Br. 47.

First, to the extent Appellant seeks an explicit suggestion or motivation in the reference itself, this is no longer the law in view of the Supreme Court’s recent holding in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007). Since the Examiner has provided some articulated reasoning with some rational underpinning for why a person with ordinary skill in the art would modify one reference over the other (FF 6,13), Appellant’s argument is not persuasive as to error in the rejection.

We thus disagree with Appellant because the Examiner has provided an articulated line of reasoning for the reasons for combining.

*Claim 28*

Claim 28 recites: *receiving manuscript data comprises receiving at a central computer manuscript data defining a completed manuscript transmitted from a remote terminal associated with an author; and in response to receiving at said central computer system a signal indicating that a first potential reviewer disagrees to review said manuscript, generating at said central computer and transmitting to a second potential reviewer at a remote terminal a request prompting said second potential reviewer to review said complete manuscript.*

The Examiner found that the combination of Plantz and Hager disclose the limitations of this claim except for the teaching of prompting another potential reviewer for agreement to review said manuscript if a first potential reviewer disagrees to review said manuscript and thus relies on Price (Answer 8).

Appellant argues however that “Price does not teach generating at a computer and transmitting to a second potential reviewer at a remote terminal a request prompting the second reviewer to review the complete manuscript...” (Appeal Br. 47). While it is true that Price is silent on this feature, the rejection is based on a combination with Plantz, which discloses using plural reviewers in the context of keeping plural grammar editors on staff to support grammar reviews ((FF 6-9). A person with ordinary skill in the art would understand that since plural reviewers, such as the grammar reviewees in Plantz all have access to the document by virtue of their passwords, and if one such reviewer refuses, or by act of omission, does not review the document, another who is working from his/her own computer would be prompted to do the work. *See KSR Int’l. Co. v. Teleflex Inc.*, 127

S.Ct. 1727, 1741 (2007) (In making the obviousness determination one “can take account of the inferences and creative steps that a person of ordinary skill in the art would employ”).

## NEW GROUNDS OF REJECTION

We enter a new ground of rejection as to claim 1 under 35 U.S.C. § 101 in light of the recent decision in *In re Bilski*. In this case the court held that the test to determine whether a claimed process recites patentable subject matter under § 101 is whether: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. *In re Bilski*, 545 F.3d 943, 961-62 (Fed. Cir. 2008) (en banc).

In claim 1, although the preamble does recite the phrase “a computer implemented process”, the body of the claim fails to integrate this recitation enough to make it a positive limitation. Instead, we interpret the recitation as an intent to use or field of use type recitation, thereby making the claim devoid of language which ties it to a particular machine or apparatus. Field of use recitations are typically found in the preamble of claims, and the weight given them largely depends on how the recitation is subsequently used in the body of the claim. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 1306 (Fed. Cir. 1999). Whether a preamble statement that the “patent claims a method of or apparatus for...[x] is not merely a statement describing the invention’s intended field of use ... [depends upon if] that statement is intimately meshed with the ensuing language in the claim.” *Id.* at 1306. In other words, “if the preamble merely state[s] a

purpose or intended use and the remainder of the claim completely defines the invention independent of the preamble,” it does not constitute a limitation. *Lipscomb’s Walker on Patents, 3<sup>rd</sup> Edition, Vol. 3, § 11.11* at p. 361 (citing *Marston v. J.C. Penney Co.* (4<sup>th</sup> Cir. 1965)); *See also, Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997); *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989) (An element initially recited in the preamble, is thereafter fully incorporated into the body of the claim so as to breathe life and breath into it by setting forth the complete combination).

As to the second part of the test, we find nothing in the claim whereby it transforms a particular article into a different state or thing. The claimed steps of “receiving”, “prompting” and “storing” do not involve transformation, but rather only the tracking of information which remains and must remain unaltered because its validity goes to the essence of the agreement by the reviewer agrees to work on the document and ensuing rights connected thereto.

### CONCLUSIONS OF LAW

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 1, 2-14, and 14-32, and has shown that the Examiner erred in rejecting claims 33 and 34 under 35 U.S.C. § 103(a).

We conclude that the Appellant has not shown that the Examiner erred in rejecting rejected claims 1-2, 4-12, 14-27, and 29-32 under 35 USC 103(a) as being unpatentable over Plantz in view of Hager; and claim 28 under 35 USC § 103 (a) as being unpatentable over Plantz in view of Hager and further in view of Price.

We conclude that the Appellant has shown that the Examiner erred in rejecting rejected claims 33 and 34 under 35 USC 103(a) as being unpatentable over Plantz in view of Hager.

## DECISION

The decision of the Examiner to reject claims 1, 2-14, and 14-32 is **AFFIRMED** and the decision to reject claims 33 and 34 is **REVERSED**.

Under 37 C.F.R. § 41.50(b) a new ground of rejection has been entered as to claim 1 under 35 U.S.C. § 101.

37 C.F.R. § 41.50(b) provides that, “[A] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Regarding the new ground of rejection, Appellant must, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, exercise one of the following options with respect to the new ground of rejection, in order to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . ; or

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED IN PART 37 C.F.R. § 41.50(b)

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